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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,439	02/06/2004	Leonard J. Gaik	1685-2/AMK	5149
38735 7590 01/24/2008 DIMOCK STRATTON LLP 20 QUEEN STREET WEST SUITE 3202, BOX 102 TORONTO, ON M5H 3R3 CANADA			EXAMINER NGUYEN, THUY-VI THI	
			ART UNIT 3629	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/772,439

Applicant(s)

GAIK, LEONARD J.

Examiner

THUY-VI NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. As claim 1 recites in the preamble "a provider of music to an operator of a public medium". It is interpreted that the provider of music is providing the music to the operator. The second limitation recites "transferring said right to play music to the provider of music ", the examiner however interprets that the operator is providing the music to the provider of music. Moreover, as claim 2, first limitation recites "delivering said selection of music from said provider of music to said operator", it is interpreted the other way around of the second limitation of claim 1 which is provider of music is providing the music to the operator. There is insufficient antecedent basis for the limitations of claims between the provider of music and the operator.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilks (US Patent Application Publication US 2002/0129693).

Regarding to claim 1, Wilks discloses a method of arranging for a provision of music from a provider of music to an operator of a public medium comprising the following steps:

acquiring from the operator a right to play a selection of music in said public medium [...interactive multimedia system (IMS 12) is an operator that allows a user to search the selected song to downloaded and authorizes to play songs; see par. 0016, par. 0031, lines 21-23 and figure 1].

transferring said right to play music to the provider of music [...sending and receiving the selection of song from (IMS 12) to the remote server (RS 18) /provider of music); see par. 0035, lines 4-13 and figure 1].

Regarding to claim 2, Wilks discloses delivering said selection of music from said provider of music to said operator [see par. 0008, lines 1-6; par. 0041]; and playing said selection in said public medium [see par. 0008, lines 1-6; par. 0010, lines 1-5; par. 0012].

Regarding to claim 3, Wilks discloses the step of selecting the operator [operator such as restaurant, bars, client computer; par. 0007, lines 2-5; par. 0015, lines 1-2].

Regarding to claim 4, Wilks discloses the step of selecting the provider of music [see par. 0012, lines 4-6];

Regarding to claim 5, Wilks discloses the step of selecting the operator [...operator such as restaurant, bars and client computer; par. 0007, lines 2-5; par. 0015, lines 1-2].

Regarding to claim 6, Wilks discloses the step of selecting from the provider of music an appropriate selection of music to play in said public medium [...see par. 0012, lines 3-5 and figure 3].

Regarding to claim 7, Wilks discloses the step of arranging for the payment of copyright license fees to the owners of a copyright subsisting in said music [see par. 0031, lines 12-13, lines 22-24].

Regarding to claim 8, Wilks discloses wherein the public medium is selected from a group consisting of retail stores, bars, sports stadiums, sports arenas, hand-held devices including personal communication devices, mobile phones and personal digital assistants, phone line holding ports and on-line websites [operator such as restaurant, bars, client computer; par. 0007, lines 2-5; par. 0015, lines 1-2].

Regarding to claim 9, Wilks discloses wherein the provider of music is selected from a group consisting of a record company, a record producer, a music publisher, record distributor, a recording studio, an individual artist, an individual, a

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music provider and an agent for musical artists [...music distribution company; remote multimedia server/music provider; see par. 0008, lines 6; par. 0026, lines 1-6].

Regarding to claim 10, Wilks discloses wherein the right to play a selection of music in said public medium is at a pre-determined time and for a pre-determined length of time [see par. 0031, lines 2-5].

Regarding to claim 11, Wilks discloses a method of acquiring music for an operator of a public medium to play in said medium comprising the following steps:

arranging with the operator to find a provider of music based on a set of criteria [...arranged by type of music, artist name, music type; see par. 0017, lines 3-8; par. 0040, lines 4-8 and figures 3 and 4];

selecting an appropriate provider of music based on said set of criteria; and [...selection of songs from a variety of music types; see par. 0012; par. 0017, lines 3-8 and figures 3-4].

arranging for the provider of music to acquire from the operator a right to play a selection of music in said public medium [...distribution of copyrighted music to businesses and permits a business operator to select songs to be played; see par. 0007, lines 1-5; par. 0010, lines 1-5].

Regarding to claim 12, Wilks disclose further comprising the step of delivering said music from the provider of music to the operator [see par. 0008, lines 1-6].

Regarding to claim 13, Wilks discloses wherein the provider of music is selected according to a pre-selected set of criteria provided by the operator [...remote multimedia server (RS 18) has created a menu contain the music criteria for user select; see par. 0037, lines 11-21].

Regarding to claim 14, Wilks discloses the step of selecting from the provider of music an appropriate selection of music to play in said public medium [see par. 0012, lines 3-5 and figure 3].

Regarding to claim 15, Wilks discloses the step of arranging for the payment of copyright license fees to the owners of a copyright subsisting in said music [see par. 0031, lines 12-13, lines 22-24].

Regarding to claim 16, Wilks discloses wherein the public medium is selected from a group consisting of retail stores, bars, sports stadiums, sports arenas, hand-held devices including personal communication devices, mobile phones and personal digital assistants, phone line holding ports and on-line websites [operator such as restaurant, bars, client computer; par. 0007, lines 2-5; par. 0015, lines 1-2].

Regarding to claim 17, Wilks discloses wherein the provider of music is selected from a group consisting of a record company, a record producer, a music publisher, a record distributor, a recording studio, an individual artist, a music provider and an agent for musical artists [...music distribution company; remote multimedia server/music provider; see par. 0008, lines 6; par. 0026, lines 1-6].

Regarding to claim 18, Wilks discloses wherein the right to play a selection of music in said public medium is at a pre-determined time and for a pre-determined length of time [see par. 0031, lines 2-5].

Regarding to claim 19, Wilks discloses a method of arranging a business transaction comprising the following steps:

selecting a provider of music [...selecting a variety of artist; see par. 0012; lines 3-6];

selecting an operator of a public medium wherein said medium is appropriate for playing music of the provider of music based on a set of pre-determined criteria provided by said operator [...interactive multimedia system (IMS12) provides a menu with including the music criteria for a user to chose and play; see par.0014, lines 12-14; par. 0016; par. 0017, lines 4-9 and figures 1-2].

arranging for the provider to acquire from the operator a right to play a selection of music in said public medium [...interactive multimedia system (IMS 12) is an operator that allows a user to search the selected song to downloaded and authorizes to play songs; see par. 0016, par. 0031, lines 21-23 and figure 1].

Regarding to claim 20, Wilks discloses the step of arranging for the payment of copyright license fees to the owners of a copyright subsisting in said music [see par. 0031, lines 12-13, lines 22-24].

Regarding to claim 21, Wilks discloses wherein the public medium is selected from a group consisting of retail stores, bars, sports stadiums, sports arenas, hand-held devices including personal communication devices, mobile

phones and personal digital assistants, phone line holding ports and on-line websites [operator such as restaurant, bars, client computer; par. 0007, lines 2-5; par. 0015, lines 1-2].

Regarding to claim 22, Wilks discloses wherein the provider of music is selected from a group consisting of a record company, a record producer, a music publisher, a record distributor, a recording studio, an individual artist, a music provider and an agent for musical artists [...music distribution company; remote multimedia server/music provider; see par. 0008, lines 6; par. 0026, lines 1-6].

Regarding to claim 23, Wilks discloses wherein the right to play a selection of music in said public medium is at a pre-determined time and for a pre-determined length of time [see par. 0031, lines 2-5].

Regarding to claim 24, Wilks disclose a method of conducting a business transaction between a provider of music and an operator of a public medium [...communication between (IMS 12)/operator and (RS 18)/provider of music; see par. 0032, lines 11-12] comprising the step of arranging for the acquisition of a right to play a selection of music in said public medium by the provider from the operator [...authorizes to play songs from the operator (IMS 12); see par. 0031, lines 1-7; lines 21-23 and figure 1].

Regarding to claim 25, Wilks discloses wherein the right to play a selection of music in said public medium is at a pre-determined time and for a pre-determined length of time [see par. 0031, lines 2-5].

Regarding to claim 26, Wilks discloses a method for an operator of a public medium to acquire music for playing in said public medium comprising the step of transferring to a provider of music a right to play a selection of music in said public medium [...sending and receiving the selection of song form (IMS 12) to the remote server (RS 18)/provider of music); see par. 0035, lines 4-13 and figure 1].

Regarding to claim 27, Wilks discloses wherein the right to play a selection of music in said public medium is at a pre-determined time and for a pre-determined length of time [see par. 0031, lines 2-5].

Regarding to claim 28, Wilks discloses a method for a provider of music to acquire the right to play music in a public medium comprising the step of acquiring from an operator of a public medium a right to play a selection of music in said public medium [...interactive multimedia system (IMS 12) is an operator that allows a user to search the selected song to downloaded and authorizes to play songs; see par. 0016, par. 0031, lines 21-23 and figure 1].

Regarding to claim 29, Wilks discloses wherein the right to play a selection of music in said public medium is at a pre-determined time and for a pre-determined length of time [see par. 0031, lines 2-5].

Regarding to claim 30, Wilks disclose wherein there is no cost to a member of the public for accessing said music from said public medium [see par. 0006, lines 1-4].

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. The US Patents to Wolfe et al. disclose a system and method for delivering programmed music and targeted advertising messages to Internet, and to Gimarc disclose discloses system and method for time-shortening songs. The US Patent application publication to Matsukawa discloses advertisement distribution system with digital contents, and to Powers disclose the distributor system provides copyrighted digital material to the user.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrence Till can be reached on 571-272-1280. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR

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only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thuy-Vi Nguyen/

Examiner, Art Unit 4175

/Brian D Nash/
Primary Examiner, Art Unit 3721